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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/538,805 | 03/30/2000 | Jay S. Walker | 99-077 | 7826 |

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EXAMINER

CUFF, MICHAEL A

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 08/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/538,805

Applicant(s)

WALKER ET AL.

Examiner

Michael Cuff

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 06 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-57 and 59-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-34, 43, 45-50, 52-54, 57 and 59-64 is/are rejected.
- 7) ☐ Claim(s) 35-42, 44, 51, 55 and 56 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. Applicant has provided documents Q and DD from the IDS. These documents have been considered.

Specification

2. The objection to the specification from the last office action is maintained. Applicant has described in the arguments what is meant by the means plus function terms but did not amend the specification. This helps the examiner and the record, but it does not help the future reader of the patent.

Claims

3. The claim objection and the 35 USC 101 rejection have been withdrawn. In reference to the claim language in claims 60-62, applicant has replaced adapted to language with intended use language, which is also given little patentable weight. Applicant has filed a terminal disclaimer in response to the double patenting rejection in reference to US patent 6,415,262. Applicant has successfully argued the other double patenting issues.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3627

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-34, 43, 45-50, 52-54, 57, and 59-64 are rejected under 35

U.S.C. 102(b) as being anticipated by Green et al.

Green et al. Shows, figure 2, a remote ordering system. The customer identifies a product to the system. (receiving information) The system searches multiple merchants, which are selectable. (identifying at least a first and second retailer) One of the products envisioned by Green et al. (column 13, line 49) is a prescription. (a prescription meets the definition of the broad term "subscription". From Webster's Ninth New Collegiate Dictionary, "an arrangement for providing, receiving, or making use of something of a continuing or periodic nature on a prepayment plan." A prescription is paid for (prepay) and then the drug is used on a continuing basis.) The product may be picked up at the selected merchant. (valid at the first retailer) The price (terms of the subscription) of the product is determined by looking up the price in a database by computer 12. The order, with the customer ID/pricing (terms), is sent to the merchant. (quantity is an inherent feature of a prescription) Tracking, paying, quantity discounts, optional payment plans, and identifying customers as part of authorization are all inherent features of basic business practice.

Allowable Subject Matter

5. Claims 35-42, 44, 51 and 55-56 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


The following is a statement of reasons for the indication of allowable subject matter:

Claims 35-40, 44 and 51 recite the use of a penalty for failure to comply with the terms of the subscription. This would not make sense with the prescription art used in the rejection.

Claims 41-42 and 55-56 recite the limitation of a second or modified subscription deal. This would not make sense with the prescription art used in the rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Cuff whose telephone number is (703) 308-0610. The examiner can normally be reached on 8:00 to 5:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

 8/25/03
Michael Cuff
August 25, 2003